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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/772,473

02/05/2004

George Bokisa

TASKP103US

4978

23623

7590

06/26/2007

AMIN, TUROCY & CALVIN, LLP

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EXAMINER

WONG, EDNA

ART UNIT

PAPER NUMBER

1753

MAIL DATE

DELIVERY MODE

06/26/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)	
	10/772,473	BOKISA ET AL.	
	Examiner	Art Unit	
	Edna Wong	1753	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 June 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 13 June 2007. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

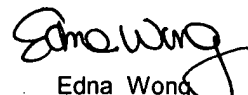
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-13, 15, 23, 24 and 26-29.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: page 2-7.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.


Edna Wong
Primary Examiner
Art Unit: 1753

ADVISORY ACTION

This is in response to the Amendment After Final dated June 13, 2007. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Response to Arguments

Claim Objections

Claims **4 and 6** has been objected to because of minor informalities.

The objection of claims 4 and 6 has been withdrawn in view of Applicants' amendment.

Claim Rejections - 35 USC § 112

Claims **6 and 28** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The rejection of claims 6 and 28 under 35 U.S.C. 112, second paragraph, has been withdrawn in view of Applicants' amendment.

Claim Rejections - 35 USC § 103

I. Claims **1-8 and 23** have been rejected under 35 U.S.C. 103(a) as being unpatentable over **JP 10-245693** ('693) in combination with **Passal** (US Patent No.

3,697,391).

The rejection of claims 1-8 and 23 under 35 U.S.C. 103(a) as being unpatentable over JP 10-245693 ('693) in combination with Passal is as applied in the Office Action dated December 12, 2006 and incorporated herein. The rejection has been maintained for the following reasons:

Applicants states that that there is NO teaching or suggestion in JP '693 indicating that its N-heterocyclic quaternary ammonium salt brighteners would be effective for improving the appearance of Ni-Co-B alloys.

Applicants state that there is NO teaching or suggestion in JP '693 indicating that its N-heterocyclic quaternary ammonium salt brighteners cause the uniform placement of boron, in an electroless fashion, within the matrix of a Ni-Co alloy.

Applicants state that since neither JP '693 nor Passal teach or suggest causing the uniform placement of boron within the matrix of a Ni-Co alloy, one skilled in the art would not have employed an acetylenic brightener in JP '693.

In response, a known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use (*In re Gurley*, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994); and MPEP § 2145(X)(D)(1)).

Inoperativeness of a reference is not established by merely showing that a particular disclosed embodiment is lacking in perfection does not establish non-obviousness. *Ex parte Allen* 2 USPQ 2d 1425 (BPAI 19870; *Decca Ltd. V. United States*

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191 USPQ 439 (Ct. Cl. 1976); *Bennett v. Halahan* 128 USPQ 398, 401 (CCPA 1961).

Applicants state that since neither JP '693 nor Passal teach or suggest that an acetylenic brightener works as an effective surfactant to suppress the deposition of metal, one skilled in the art would not have replaced the N-heterocyclic quaternary ammonium salt brightener with an acetylenic brightener.

Applicants state that acetylenic brighteners and pyridinium salt brighteners are structurally different and non-equivalent.

Applicants state that one skilled in the art would NOT have replaced the N-heterocyclic quaternary ammonium salt brightener of JP '693 with any of the brighteners of Passal since the essential function of plating inhibition is clearly absent.

In response, even if one having ordinary skill in the art did not replace a pyridinium brightener disclosed by JP '693 with a brightener disclosed by Passal, there was no reason why one having ordinary skill in the art could not have added a second brightener into the bath in addition to the pyridinium brightener disclosed by JP '693 because according to Passal, additives that work in combination give the best results (cols. 3-4).

Claim 1, as presently written, is open to having a pyridinium brightener in the bath along with the acetylenic brightener. Thus, where Applicants claim a process in terms of a function, property or characteristic and the process of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, the

function, property or characteristic would have been inherent (MPEP §2112(III)).

Applicants state that there is NO teaching or suggestion in Passal indicating that its acetylenic brighteners improve the appearance of electrodeposited Ni-Co-B alloys, and there would have been no reason to expect such an outcome. Therefore, one skilled in the art would NOT have used any of the brighteners of Passal in the method of JP '693.

In response, the reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by the Applicants. *In re Linter* 458 F.2d 1013, 173 USPQ 560 (CCPA 1972); *In re Dillon* 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), *cert. denied*, 500 US 904 (1991); and MPEP § 2144.

Claim 1, as presently written, is open to having a pyridinium brightener in the bath along with the acetylenic brightener. One having ordinary skill in the art would have combined a combination of additives, including the N-heterocyclics, disclosed by Passal (col. 3, lines 3-9; and col. 11, Example 8) for any of the reasons he discloses because a skilled artisan in looking to develop a nickel-cobalt-boron alloy bath for use at an acidic pH would look at the additives in the prior art for their functioning in an electroplating bath. The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It

is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by the Applicants. *In re Linter* 458 F.2d 1013, 173 USPQ 560 (CCPA 1972); *In re Dillon* 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), *cert. denied*, 500 US 904 (1991); and MPEP § 2144.

II. Claims **9-12, 15 and 24** have been rejected under 35 U.S.C. 103(a) as being unpatentable over **JP 10-245693** ('693) in combination with **Passal** (US Patent No. 3,697,391).

The rejection of claims 9-12, 15 and 24 under 35 U.S.C. 103(a) as being unpatentable over JP 10-245693 ('693) in combination with Passal is as applied in the Office Action dated December 12, 2006 and incorporated herein. The rejection has been maintained for the reasons as discussed above.

Applicants' remarks have been fully considered but they are not deemed to be persuasive.

III. Claim **13** has been rejected under 35 U.S.C. 103(a) as being unpatentable over **JP 10-245693** ('693) in combination with **Passal** (US Patent No. 3,697,391) as applied to claims 9-12, 15 and 24 above, and further in view of **SU 1,544,847** ('847).

The rejection of claim 13 under 35 U.S.C. 103(a) as being unpatentable over JP 10-245693 ('693) in combination with Passal as applied to claims 9-12, 15 and 24 above, and further in view of SU 1,544,847 ('847) is as applied in the Office Action

dated December 12, 2006 and incorporated herein. The rejection has been maintained for the reasons as discussed above.

Applicants' remarks have been fully considered but they are not deemed to be persuasive.

IV. Claims **26-29** have been rejected under 35 U.S.C. 103(a) as being unpatentable over **JP 10-245693** ('693) in combination with **Passal** (US Patent No. 3,697,391).

The rejection of claims 26-29 under 35 U.S.C. 103(a) as being unpatentable over JP 10-245693 ('693) in combination with Passal is as applied in the Office Action dated December 12, 2006 and incorporated herein. The rejection has been maintained for the reasons as discussed above.

Applicants' remarks have been fully considered but they are not deemed to be persuasive.

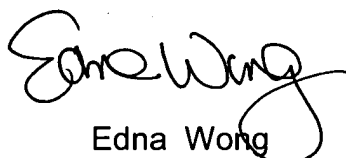
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edna Wong whose telephone number is (571) 272-1349. The examiner can normally be reached on Mon-Fri 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Edna Wong
Primary Examiner
Art Unit 1753

EW
June 22, 2007